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DATE: October 25, 2005

TO: Examiner Jiping Lu
Group Art Unit 3749

FAX #: 571-273-8300

PHONE #: 571-272-4878

Application No.: 10/826,651
Applicant: Morris et al.
Due Date: October 25, 2005

OUR REF.: 1915.24US04

FROM: Wm. Larry Alexander
PHONE #: 612-349-5757

Attached please find the following for filing in the above-identified application.

- (1) Notice of Appeal (1 pg.); and
- (2) Pre-Appeal Brief Request for Review (5 pgs.).

Respectfully submitted,



Wm. Larry Alexander
Registration No. 37,269

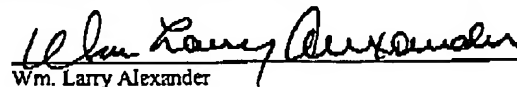
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CERTIFICATE OF FACSIMILE TRANSMISSION

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Wm. Larry Alexander

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PATENT APPLICATION

IN THE UNITED STATES

DEMARK OFFICE

In re the application of:

Attorney Docket No.: 1915.24US04

Morris et al.

Confirmation No.: 2287

Application No.: 10/826,651

Examiner: Jiping Lu

Filed: 16 April 2004

Group Art Unit: 3749

For: PRECIPITATION RESISTANT RIDGE VENT

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the 25 July 2005 Office Action. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for reasons stated on the attached sheets.

Please grant any extension of time necessary for entry; charge any fee due to Deposit Account No. 16-0631.

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25 October, 2005
Date

Wm. Larry Alexander
Wm. Larry Alexander

Application No. 10/826,651
Pre-Appeal Brief Request for Review

35 U.S.C. § 103

In the 25 July 2005 Final Office Action, claims 1-37 are rejected under 35 U.S.C. § 103(a) as obvious over WO 99/35446 ("Morris"), in view of U.S. 6,298,613 ("Coulton et al."). This rejection essentially restates the rationale stated in the 24 March 2005 Non-Final Office Action. Applicant traverses that the required motivation to modify the disclosure of Morris with the disclosure of Coulton et al. has been shown in view of the reasons stated in the 3 May 2005 Amendment, beginning at page 10.

Applicant more specifically submits that the required motivation has not been established because neither Morris nor Coulton et al. disclose or suggest that the "ventilation efficiency" would be improved for reasons stated in the 3 May 2004 Amendment, beginning at line 1, page 13.

Applicant additionally submits that the requisite motivation has not been established because the unsupported opinion stated in the rejection is not sufficient to show the required motivation for reasons stated in the 3 May 2005 Amendment, beginning in the first full paragraph of page 13.¹

Aside from incorrectly asserting that unsupported opinion properly establishes the requisite motivation, the final rejection in the 25 July 2005 Final Office Action, in the Response to Arguments section, asserts that because "each and every claimed element is clearly shown or taught by the references," Applicant must "point out from the claims exactly which element that the references do not teach or [show]." Apparently the rejection asserts that because all claims

¹ See footnote 8 in the 3 May 2004 Amendment.

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limitations are arguably disclosed in one of Morris or Coulton et al., the requisite motivation is inherently present. Applicant first points out that, aside from the required motivation, all claim limitations must be present to establish a prima facie case of obviousness.² However, the all limitations rule is not at issue here. What is at issue is that it is well settled that whether all claim limitations are known has no bearing on the issue of motivation.³ Thus, whether or not all claim limitations are present in one of Morris or Coulton et al. is not dispositive of whether a person of ordinary skill in the art would be motivated to modify these documents to achieve a device with the features described by the pending claim limitations.

At page 3, beginning at line 3, the Response to Arguments section of the 25 July 2005 Final Office Action correctly states that the required motivation can be present in the "references themselves or in the knowledge generally available to one of ordinary skill in the art." To this end, Applicant respectfully points out that specific support from the prior art for the asserted motivation must be cited in the rejection.⁴ Hence, citations from portions of Morris, Coulton et al., or another prior art document are required to establish the required motivation. Alternatively, an affidavit or declaration from the Examiner asserting specific facts supporting that the

² See footnote 1 in the 3 May 2005 Amendment.

³ See, Abbott Laboratories v. Syntrol Bioresearch Inc., 67 USPQ2d 1337, 1347 (Fed. Cir. 2003) ("Syntrol cites a statement by an expert for Abbott that the use of the fluid sample to drive the flow was known in the prior art. [Citation omitted.] Knowledge in the prior art of every element of a patent claim, however, is not of itself sufficient to render the claim obvious. Graham v. John Deere Co., 383 U.S. 1, 17-18 [149 USPQ2d 459] (1966); Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313, 1328, 63 USPQ2d 1374, 1383 (Fed. Cir. 2002). The issue is whether substantial evidence supports the judgment ... that a person having ordinary skill in the art would not have been motivated to replace the developing fluid/sample solution combination of Deutsch with flow provided solely by sample fluid.").

⁴ See, footnotes 8 and 9 of the 3 May 2005 Amendment.

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motivation was generally present in the art at the time of the invention is required if some other citation cannot be provided.

As shown beginning on page 14, first full paragraph, of the 3 May 2005 Amendment, Applicant further respectfully submits that the rejection fails to establish the requisite and specific motivation for securing the claimed filter material "to the bottom surface of the at least one vent part and to the top panel," as recited in claim 1; for attaching the claimed air permeable filter "to the bottom surface of the top panel and positioned to filter air being conveyed through the top panel air passages or the vent air part air passages," as recited in claim 13; extending the claimed filtering material "between the top panel and the bottom surface of one of the vent parts," as recited in claim 14; "allowing air exchange between the structure interior and the environment via the top panel air passages, the vent part air passages, and the filter material," as recited in claim 15; "securing an air permeable filter material to an interior surface of the top panel and to the vent part," as recited in claim 16; and "the filter material secured to the bottom surface of the vent part and to the top panel," as recited in claim 26.⁵ Applicant respectfully submits that none of the foregoing claim limitations are disclosed or suggested by either Morris or Coulton. Applicant points out that the 25 July 2005 Final Office Action failed to establish the required motivation for any of these specific limitations. Thus, in addition to not showing the requisite motivation for adding a filter per se to the disclosure of Morris, motivations for the foregoing specific limitations must be established as well if a prima facie case of obviousness is to be established.


⁵ See, page 14, first full paragraph of the 3 May 2005 Amendment.
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Conclusion

The cited case law and MPEP sections, as cited in the 3 May 2005 Amendment and herein, show that unsupported opinion stated in a rejection and whether limitation are "known" are not sufficient to show the requisite motivation necessary to establish a prima facie case of obviousness. Indeed, these authorities clearly document that a proper rejection for obviousness must include some specific citation from the prior art to support the requisite motivation or must include a declaration or affidavit from the Examiner asserting specific facts supporting the assertion that the requisite motivation was generally present in the prior art at the time of the invention.⁶ However, the final rejection in the 25 July 2005 Office Action fails to contain the required citation, affidavit, or declaration. Therefore, the requisite motivation to modify the disclosure of Morris with the disclosure of Coulton et al. has not been shown. Because the required motivation has not been shown, a prima facie case of obviousness has not been established with respect to the pending claims.

Respectfully submitted,


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⁶ See, footnotes 2-9 of the 3 May 2005 Amendment.